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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,233	08/26/2003	Chiung-Tong Chen	12563-019001	6205
26161	7590	05/23/2005	EXAMINER	
FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110			STOCKTON, LAURA	
			ART UNIT	PAPER NUMBER
			1626	

DATE MAILED: 05/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/649,233

Applicant(s)

CHEN ET AL.

Examiner

Laura L. Stockton, Ph.D.

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 13-31 and 33-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08).
Paper No(s)/Mail Date April 19, 2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

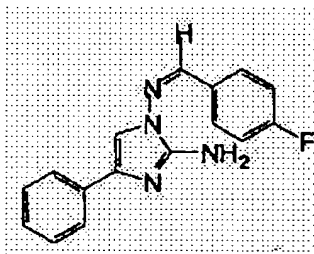
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DETAILED ACTION

Claims 1-41 are pending in the application.

Election/Restrictions

Applicants' election without traverse of Group I, and the species of the first exemplary compound listed in the scheme on page 3 of the instant specification (reproduced below) in the reply filed on April 20, 2005 is acknowledged.



The requirement is still deemed proper and is therefore made FINAL.

Claims 13-31 and 33-41 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being

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drawn to nonelected inventions. Election was made
without traverse in the reply filed on April 20, 2005.

It is suggested that in order to advance
prosecution, the non-elected subject matter be
cancelled when responding to this Office Action.

Information Disclosure Statement

The Information Disclosure Statement filed on
April 19, 2004 has been considered by the Examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the second
paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly
pointing out and distinctly claiming the subject matter which the applicant
regards as his invention.

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Claims 1-12 and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 32, under the definition of R_a and R_b , "cyano, haloalkyl" should be changed to "cyano or haloalkyl". In claim 3, R_4 representing a cyano substituted phenyl lacks antecedent basis. Claim 4 lacks antecedent basis from claim 2 because R_2 does not represent an optionally substituted phenyl in claim 2. Claim 7 lacks antecedent basis from claim 2 because R_2 does not represent an optionally substituted phenyl in claim 2. In claim 10, R_4 representing a cyano substituted phenyl lacks antecedent basis. In claim 12, a number of specie are not embraced by claim 1 and therefore, lack antecedent basis from claim 1. See the third, fifth and sixth compounds in row 1; the first, second, third and fifth compounds in row 2; the first,

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second, third, fourth and sixth compounds in row 3; the third and fourth compounds in row 4; the first, fourth and fifth compounds in row 5; and the first and second compounds in row 6.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2 and 10 are rejected under 35

U.S.C. 102(a) as being anticipated by:

a) CA Registry No. 388609-03-8, entry date into Registry file on STN is January 31, 2002;

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b) CA Registry No. 388093-36-5, entry date into Registry file on STN is January 30, 2002;

c) CA Registry No. 352656-72-5, entry date into Registry file on STN is August 27, 2001; or

d) Miyamoto {Journal of Heterocyclic Chemistry (Jan-Feb 2002), 39(1), pages 157-162} - see compound 1a on page 157.

Each of the above prior art disclose a compound which is embraced by the instant claimed invention.

Claims 1 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by:

a) CA Registry No. 319429-16-8, entry date into Registry file on STN is February 2, 2001;

b) Lalezari et al. {CA 81:105459, 1974} - see the compound of CA Registry No. 53454-64-1;

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c) Harmon et al. {Journal of Pharmaceutical Sciences (1970), 59(5), page 724} - see compounds 7 and 8 in Table I on page 724; or

d) Krimer et al. {CA 126:89305, 1996} - see, for example, the compound of CA Registry No. 181190-50-1.

Each of the above prior art disclose a compound which is embraced by the instant claimed invention.

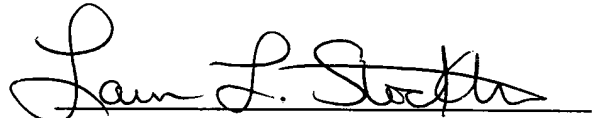
The elected species, the first exemplary compound listed in the scheme on page 3 of the instant specification, is allowable over the art of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (571) 272-0710. The examiner can normally be reached on Monday-Friday from 6:15 am to 2:45 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (571) 272-0699.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The Official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

A handwritten signature in cursive script, reading "Laura L. Stockton", written over a horizontal line.

Laura L. Stockton, Ph.D.

Patent Examiner

Art Unit 1626, Group 1620

Technology Center 1600

May 16, 2005